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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,481

11/19/2003

Fred C. Casto

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10/06/2006

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,481

Applicant(s)

CASTO ET AL.

Examiner

William L. Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Examiner's comments.

DETAILED ACTION

Examiner's Response

1. In response to the application filed 11/19/2003, the application has been examined. The Examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. It is the Examiner's position that claims 1-28 are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claims 23-26, the claims are replete with the phrase "**each such device**" or "**each such pair**" or "**each such magnetic card**". It has been established that the phrase "**such as**" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). In this case, it is unclear what "device or pair" is a part of the claimed invention. It is unclear what such device or such pair is being referred to.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1-2, 5-10, 16-22 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,557,758 {hereinafter 'Monico'}.

In claim 1, Monico teach of a method for automated preparation of radio-frequency devices 21 for distribution, the method comprising:

In box 10 shown in Figure 1: receiving a radio-frequency device, the device comprising an embedded radio-frequency transponder (i.e. RFID tag 22). Although Monico does not disclose a plurality of RFID tags, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention, to include a plurality of RFID tags in the package delivery of Monico because when there are a plurality of packages to be delivered, the plurality of packages will require a plurality of RFID tags.

sequentially moving each of the radio-frequency devices to a plurality of stations (i.e. boxes 10, 11, 12, 13) of a preparation device shown in Figure 1;

In box 13: encoding, at a first station, a radio-frequency identification code (i.e. serial number, coded information, shipping and tracking data) assigned to the each of the radio-frequency devices {col. 3, lines 39-47};

identifying (i.e. reading and checking) a recipient for the each of the radio-frequency devices {col. 4, lines 44-54}; and

In box 12 or 17: labeling, at a second station, a package containing the each of the radio- frequency devices with a mailing address for the recipient {paragraph bridging cols. 3 and 4}.

In claim 2, the method recited in claim 1 further comprising:

reading, at a third station, the radio-frequency identification code from the each of the radio-frequency devices {col. 4, lines 46-50}; and

verifying (i.e. checking) that the read radio-frequency identification code matches the assigned radio-frequency identification code {col. 4, lines 50-53+}.

In claims 5 and 6, the method recited in claim 1 wherein:

In box 11: receiving the plurality of such radio-frequency devices comprises receiving each such device in an enclosure (i.e. package); and

encoding the radio-frequency identification code is performed without removing the each of the radio-frequency devices from the enclosure.

In claim 7, the method recited in claim 1 further comprising encapsulating (i.e. shown in Figure 2) the each of the radio-frequency devices (i.e. product 21) in material (i.e. package 21) to produce a structure of a standard size (i.e. conventional structure) {col. 3, lines 26-30+}, wherein the preparation device is adapted to move objects of the standard size to the plurality of stations as shown in Figure 1.

In claim 8, the method recited in claim 7 wherein encapsulating the each of the radio-frequency devices comprises heat shrink wrapping (i.e. shrink-wrap plastic) the each of the radio-frequency devices {col. 3, lines 26-27+}.

In claim 9, the method recited in claim 1 further comprising affixing (i.e. applied with a label, mixed, attached, etc.) {col. 4, lines 17-22} the each of the radio-frequency devices 22 to a backboard 21 having a standard size (i.e. conventional structure) {col. 3, lines 26-30+}, wherein the preparation device is adapted to move objects of the standard size to the plurality of stations as shown in Figure 1.

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In claim 10, the method recited in claim 1 further comprising inserting the each of the radio-frequency devices into an envelope for mailing to the recipient {col. 3, lines 26-27}.

Claim 16 recites the combination of claims 1 and 7 and therefore rejected for the same reasons.

Claim 17 recites the limitations of claim 2 and therefore rejected for the same reasons.

Claim 18 recites the limitations of claim 8 and therefore rejected for the same reasons.

Claim 19 recites the limitations of claim 10 and therefore rejected for the same reasons.

Claim 20 recites the combination of claims 1 and 9 and therefore rejected for the same reasons.

Claim 21 recites the limitations of claim 2 and therefore rejected for the same reasons.

Claim 22 recites the limitations of claim 10 and therefore rejected for the same reasons.

Claim 26 recites the combination of claims 1 and 5 and therefore rejected for the same reasons.

Claim 27 recites the limitations of claim 2 and therefore rejected for the same reasons.

Claim 28 recites the limitations of claim 7 and therefore rejected for the same reasons.

6. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,557,758 {Monico} in view of US Patent 5,929,760 {hereinafter 'Monahan'}.

In claims 3 and 4, Monico does not disclose providing radio-frequency shielding as claimed. However, providing radio-frequency shielding is conventional in automated preparation of radio-frequency devices (i.e. RFID tag) for distribution as evidenced by Monahan. Monahan teaches that it is necessary to provide radio-frequency shielding if several radio-frequency devices are following one another in close succession during movement along a conveyor of a preparation device because during said movement, signal degradation may occur resulting from noisy environment {Monahan, col. 1, lines 46-55}. In this case, although reading or writing is still possible, if the signal that is read from or written into the RFID tag is degraded, the result is unintelligible. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include shielding as claimed, in the system of Monico because, as taught by Monahan, signal degradation may occur resulting from noisy environment and therefore signals read from or written into the RFID tag is unintelligible.

7. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,557,758 {Monico} in view of US Patent 5,776,278 {hereinafter 'Tuttle et al'}.

In claim 11, Monico does not disclose, "the plurality of such radio-frequency devices comprises receiving a reel that includes the plurality of such radio-frequency devices". However, the storage of radio-frequency devices on a reel (i.e. take-up reel as claimed) for supporting a plurality of radio-frequency devices is conventional as evidenced by Tuttle {Tuttle, col. 11, lines 11-14+}. Storing the radio-frequency device on a reel is advantageous because it makes it compatible to high-speed manual or automated product dispensing and uses {Tuttle, col. 11, lines 14-18+}. Such dispensing and use includes mail and package shipping and handling, as suggested by Tuttle {Tuttle, col. 16, lines 9-14+}. Therefore, at the time of applicant's invention, it would have been obvious to one of ordinary skill in the art to include the "radio-frequency devices stored on a reel" of Tuttle in the "package shipping and handling" of Monico because, as taught by Tuttle, it makes it compatible to high-speed manual or automated product dispensing and use (i.e. package shipping and handling).

In claim 12, the method recited in claim 11 further comprising cutting the reel between radio-frequency devices to separate the radio-frequency devices {Tuttle, col. 11, lines 19-20+}.

8. Claims 13-15 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,557,758 {Monico} in view of US Patent 6,398,109 {hereinafter 'Ohki'}, and further in view of US 2003/0057276 {hereinafter 'Appalucci et al'}.

Claims 13 and 15 recites the method of claim 1 except Monico does not disclose the method of practicing the combination of RFID devices and magnetic-stripe cards, as claimed. However, the combination of RFID devices and magnetic-stripe cards are conventional as evidenced by Ohki and ~~App~~ Appalucci. Ohki teach of a method for automated package handling system as shown in Figure 1 comprising: receiving a plurality of magnetic-stripe cards 31 in a "sending trade A" station {Ohki, col. 3, lines 51-53+; col. 4, lines 27-30+}; reading, at a third station (i.e. shown as conveying trade B in Figure 1), an identification of each of the plurality of magnetic-stripe cards from a magnetic stripe comprised by the magnetic-stripe card {Ohki, col. 4, lines 52-60+}; and determining the radio-frequency identification code to be assigned to a corresponding one of the radio-frequency devices wherein the package (i.e. bag 30 or 6) further contains the magnetic-stripe card corresponding to the each of the radio-frequency devices {Ohki, col. 5, lines 31-44+}. Ohki teaches that the combination of RFID devices (i.e. non-contact IC card 1) and magnetic-stripe card 31 is advantageous because information about packages when sequentially moved from a first station (i.e. Sending Trade A) to a third station (i.e. Receiving Trade C) can be utilized at the same time maintaining a high degree of secrecy {Ohki, col. 1, lines 52-57+}. Obviously, the package will be delivered to a destination without handlers knowing the contents of the package. It would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the combination of RFID devices and magnetic-stripe cards of Ohki in the system of Monico because, as taught by Ohki, information about packages when sequentially moved from a first station (i.e. Sending Trade A) to a third

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station (i.e. Receiving Trade C) can be utilized for delivery of the package at the same time maintaining a high degree of secrecy regarding contents of the package.

Ohki does not disclose, "the assignment or encoding of the radio-frequency identification code to a corresponding one of the radio-frequency devices is determined from the identification of the each of the plurality of magnetic-stripe cards". However, Ohki teaches that the magnetic stripe card (tag 31) contains data (code) as a reference when mechanically sorting and managing the package {Ohki, col. 3, lines 44-49+}. Further, Appalucci teaches that the magnetic-stripe card (26) is used as a primary identifier (i.e. primary identification code) while the radio-frequency device (28) used as a secondary identifier (i.e. radio-frequency identification code), is advantageous because it ensures that the information encoded is accurate and valid {Appalucci, paragraph [0034]}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to assign or encode radio-frequency identification code to a corresponding one of the radio-frequency devices determined from the identification of the each of the plurality of magnetic-stripe cards in the system of Ohki because, as taught by Appalucci, it ensures that the information encoded on both the magnetic-stripe card and RFID tag is accurate and valid.

Claim 14 recites the limitations of claim 7 and therefore rejected for the same reasons.

Claim 23 recites the combination of claims 1 and 13 and therefore rejected for the same reasons.

Claim 24 recites the limitations of claim 2 and therefore rejected for the same reasons.

Claim 25 recites the limitations of claim 10 and therefore rejected for the same reasons.

Office Contact Information

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is **(571)-272-3065**. The Examiner can normally be reached on Monday – Thursday, 8:30 AM – 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Wendy Garber can be reached on **(571)-272-7308**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

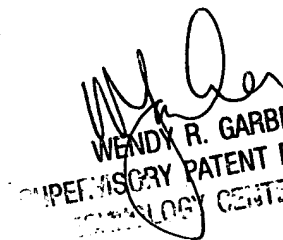
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William L. Bangachon
Examiner
Art Unit 2635

September 29, 2006



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